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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/147,175 02/25/99 DILL

E P3120-8014

PM82/0301
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EXAMINER

WOOD, K

ART UNIT

PAPER NUMBER

3632

DATE MAILED:

03/01/00

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/147,175

Applicant(s)

Dill et al.

Examiner

Kimberly Wood

Group Art Unit

3632



☒ Responsive to communication(s) filed on Oct 25, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 12-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-18 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This is the second office action for serial number 09/147,175, entitled Device For Holding A Paper Sheet, in response to Amendment A filed on October 25, 1999.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Response to Amendment

The reply filed on October 25, 1999 in response to the prior Office action concerning the claims has been entered but the amendment to the specification with respect pages 8-10 has not been entered, because the location of the insertions as indicated by the applicant are incorrect.

Claim Objections

Claim 12 is objected to because of the following informalities: "opening" should be deleted and --opening-- should be inserted.. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim17 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for first holding element and a second holding element overlapping each other partially with the second holding element having a protruding section , does not reasonably

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provide enablement for a first, second, third and fourth holding elements with the first element having a protruding section and the first and second holding elements overlapping each other.. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 14, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch 5,533,702. Koch discloses a first holding element (17) and a second holding element (29), a protruding section (the back apex of element 29).

Claims 12, 14, and 18, rejected under 35 U.S.C. 102(b) as being anticipated by Japan patent 63-23169. Japan patent discloses a first holding element (4) having two bearing zones (4a), a second holding element (5) with a protruding section (near 8), the protruding section and the bearing zones overlap (as shown in figure 9).

Claims 12-14, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiromori 5,667,183. Hiromori discloses a first element (3 or 53) with a recess (near 58a) , a second element (2 or 52), an articulating body (5 or 55), a compressible element (4) .

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Claims 12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Slavsky, Sr. 4,882,862. Slavasky, Sr. discloses a first, second, third, and fourth (21-23) holding elements, protruding sections (27).

Response to Arguments

Applicant's arguments with respect to claims 12-18 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., sheets of paper) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suzuki 5,845,889


Suzuki discloses a first and second holding element.


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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Wood whose telephone number is (703) 308-0539. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax number for this Group is (703) 308-3691.


Kimberly Wood
February 28, 2000


LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER